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10/040,049	11/07/2001	William E. Mazzara	GP-301610	1827

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EXAMINER

CAI, WAYNE HUU

ART UNIT PAPER NUMBER

2681

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,049

Applicant(s)

MAZZARA ET AL

Examiner

Wayne Cai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to Amendment dated March 01, 2006.

Response to Arguments

1. Applicant's arguments filed have been fully considered but they are not persuasive.

In response to the Office Action noted above, the Applicant intentionally traverses the Examiner's objections to independent claims 25, 37 and 46. Since the Applicant's response does not amend claim language as suggested, and does not adequately explain or point out how one skilled in the art would enable such methods as claimed. Therefore, the Examiner would maintain the objection set forth in previous office action. In addition, the Examiner would reject under 35 USC § 112 for failing to comply with the enablement requirement (please refer to the rejection set forth below).

The Applicant states, "the claimed method requires determining both the availability (see the 'determining availability' clause) and capability (see the 'determining capability' clause) **of both the at least one embedded device and the at least one portable network device**, prior to initiating a connection based on the determined capability. The Examiner's proposed modifications would change the invention, and modify the scope of the claims."

The Applicant further states, "the Examiner's explanation of the objection rings hollow. Specifically the Examiner appears to be confused by the description at page 9, lines 5-7, 'determining if a more reliable service is available on a portable network

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access device (PNAD) 245 than the service provided on the embedded device 205.'

The Examiner construes this statement as determining one or the other, but does not explain how a determination of reliability can be made without determining both. Additionally, FIG. 3 illustrates an embodiment of a method 300 to determine if a more reliable service is available on a portable network device than the service provided on the embedded device – method 300 is determining if the network access is better on the portable network device than the embedded device and therefore uses the embedded device as the base – method 300 essentially presumes the availability of the embedded device.”

The Examiner respectfully further explains the Examiner's previous position because it was not a confusion, or hollow as stated by the Applicant. Please refer to the reinforcement explanation below.

The Examiner agrees with the Applicant's assertion above that the claim language does clearly set forth at least 3 steps (Notes: This language only appears in the claim, but not in the specification): **determining availability of both the at least one embedded device and the at least one portable network device, determining capability of both the at least one embedded device and the at least one portable network device, and initiating a connection using one of the determined capability.**

The Applicant also points out Fig. 3 to support the claim language. The Applicant clearly states that determine if a more reliable service is available on a portable network device than the service provided on the embedded device (at page 7 of Remarks, and page 9, lines 1-8 of the specification). This part of the disclosure shows one skilled in

the art that after determining which device is available and more reliable, and then one of those two devices would be selected. However, the disclosure **never** suggests to one skilled of the art that **both of the devices are determined, and then only one of those two devices is selected**. The specification does not show one skilled in the art the method of determining the availability **of both** at least one embedded device **and** the at least one portable network device. Rather, the written original specification only suggests one skilled in the art to determine availability of **either** at least one embedded device **or** the at least one portable network device.

Specifically, Fig. 3, box 305, the Applicant illustrates only with the phrase "PNAD available?" in which it means that determining **only** whether PNAD is available or not available. The operation is carried out based on the determining availability of **only** PNAD device (Again, **not both** at least one embedded device **and** the at least one portable network device.)

Even if whatever the Applicant states in the Remarks are true, then at least in specification, and/or Fig.3, box 305 should have illustrated that "PNAD **and** embedded device available?"

The Examiner totally agrees with the Applicant that the Examiner's proposed modifications would change the invention, and modify the scope of the claims. However, Applicant's own disclosure is different from what is being claimed. Therefore, in term of patentability determination, it is Examiner's position to at least raise issues to make claims in a better form, or at least to make claims in accordance to the specification.

Therefore, once again, the Examiner respectfully requests the Applicant to amend claims in which they are in accordance with the disclosure. At the moment, the Examiner still maintains the objection, and introduces 35 USC 112 rejections as required.

Lastly, the Applicant argues that the cited reference, Yamashita (US 2001/0011033 A1), fails to teach or suggest, "initiating a connection to the network using one of the at least one embedded device or at least one portable network access device based on the capability determination." The Examiner respectfully disagrees with the Applicant because Yamashita teaches or suggests that initiating a connection to first radio communication or the second radio communication section based on detection signal found at box S203 or S205 of Fig. 3. The detected signal is considered as the determining capability whether the first radio communication or the second radio communication is capable to make a connection. Yamashita specifically discloses that the capability determination is based on high speed transit. On the other hand, the Applicant does not specifically specify what "capability" exactly is. Therefore, the Examiner gives the broadest reasonable interpretation to the term; hence, previous rejection was still proper.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 25, 37, and 46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In the specification:

At page 8, lines 26-29 "In one embodiment of the invention, the controller contains a central processor unit (CPU) 215 that is capable of executing a method stored in memory 220 for **determining whether the communications link with the service provider should be established by a PNAD or the embedded device.**"

At page 9, lines 1-7, "Fig. 3 shows a flow diagram of one embodiment of a method for achieving a multi-path wide area network (WAN) access to a vehicle in accordance with the present invention at 300. The method illustrated in the embodiment of 300 **determines if a more reliable service is available on a portable network access device (PNAD) 245 than the service provided on the embedded device 205.**"

The Examiner also notes that in Fig. 3, box 305, the Applicant illustrates that only determining PNAD availability is required by asking a question "PNAD available?".

Based on the portion of the specification mentioned above, and Fig. 3, the Applicant does not specifically suggest or teach the step of determining availability of **both PNAD device and the embedded device.** Rather, the specification only

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suggests that **only determining whether PNAD is available**. If it is, then go to next step. If it is not, then call on the embedded device at 350.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 25, 34, 37, and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamashita (US 2001/0011033 A1).

Regarding claims 25, 37, and 46, Yamashita discloses a method, a computer usable medium, and a system for connecting to a network, the method comprising:

- receiving a network connection request at a system master (paragraph 0051);
- determining availability of at least one embedded device, the embedded device embedded in a vehicle, and at least one portable network access device, based on the network connection request (paragraphs 0052-0053);
- determining capability of the at least one embedded device and at least one portable network access device based on the determined availability (paragraph 0034);

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- initiating a connection to the network using one of the at least one embedded device or at least one portable network access device based on the capability determination (fig. 3, boxes S204 or S202 and its descriptions).

Regarding claim 34, Yamashita discloses the method of claim 25 as described above. Yamashita also discloses wherein receiving a network connection request comprises establishing a link between the embedded device and the portable network access device (fig. 3, boxes S201, S203 and its descriptions).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 26, 33, 35, 38, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita.

Regarding claims 26, 35, and 38, Yamashita discloses the method, and computer usable medium of claims 25, and 37 as described above, except wherein the system master is the embedded device. The Examiner notes that even though Yamashita does not explicitly or specifically disclose the system master is the embedded device. However, it would be obvious to one skilled in the art to simply design or implement a portable device that could be placed in a vehicle. Hence, this claimed feature is not novel.

Regarding claims 33, and 45, Yamashita discloses the method, and computer usable medium of claims 25, and 37 as described above, except wherein the type of service is analog communication, digital communication, satellite communication, and global system for mobile communication. The Examiner, however, takes Official Notice regarding the different types of services as claimed above because it is well known in the art to use at least any one of those types in communicating or connecting between devices.

8. Claims 27-32, and 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita in view of Khullar (US – 6,748,246 B1).

Regarding claims 27, and 39, Yamashita discloses the method, and computer usable medium of claims 25, and 37 as described above. Yamashita, however, fails to disclose wherein the capability determination is based on factors selected from the group consisting of battery life viability, relative signal strength indication, service availability, type of service and call state.

In a similar endeavor, Khullar discloses a method and apparatus for selecting an access technology in a multi-mode terminal. Khullar also discloses wherein the capability determination is based on factors selected from the group consisting of battery life viability (col. 4, lines 3-5), relative signal strength indication (col. 4, lines 32-45), service availability (col. 4, lines 17-22), type of service and call state (col. 4, lines 22-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the listed factors above in order to determine the ability to make a connection or service, and make the communication more reliable and efficient.

Regarding claims 28, and 40, Yamashita, and Khullar disclose the method, and computer usable medium of claims 27, and 38 as described above. Khullar also discloses wherein the battery life viability is based on a power state and a power life (col. 4, lines 1-4).

Regarding claims 29, and 41, Yamashita, and Khullar disclose the method, and computer usable medium of claims 27, and 38 as described above. Khullar also discloses determining a calibrated threshold for the battery life viability (col. 6, lines 11-32).

Regarding claims 30, and 42, Yamashita, and Khullar disclose the method, and computer usable medium of claims 29, and 41 as described above. Khullar also discloses determining the battery life viability if the calibrated threshold is exceeded (col. 6, lines 11-32).

Regarding claims 31, and 43, Yamashita, and Khullar disclose the method, and computer usable medium of claims 30, and 37 as described above. Khullar also discloses determining a calibrated threshold for the received signal strength indication (col. 4, lines 32-45).

Regarding claims 32, and 44, Yamashita, and Khullar disclose the method, and computer usable medium of claims 31, and 43 as described above. Khullar also

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discloses determining the received signal strength indication if the calibrated threshold is exceeded (col. 4, lines 32-45).

9. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita in view of Holmstrom et al. (US – 6,741,870 B1).

Regarding claim 36, Yamashita discloses the method of claim 25 as described above, except retrying the connection initiation if connection was not established.

In a similar endeavor, Holmstrom discloses a method and system for selecting communication media. Holmstrom also discloses retrying the connection initiation if connection was not established (abstract, and col. 3, lines 1-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yamashita's invention and include the step of retrying the connection so that the system could make communication between devices.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Cai whose telephone number is (571) 272-7798. The examiner can normally be reached on Monday-Friday; 9:00-6:00; alternating Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Wayne Cai
Examiner
Art Unit 2681



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PRIMARY EXAMINER